Question Q217

National Group:	Norway
Title:	**The patentability criterion of inventive step / non-obviousness**
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Date:	18th April 2011

Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

The requirement under section 2, subsection 1 of the Patents Act is that the invention must "differ essentially" from the state of the art. This corresponds to Article 56 of EPC which states that the invention must not have been obvious to a skilled person with respect to the state of the art. It is not disputed that the threshold for inventive step pursuant to the Norwegian Patents Act and EPC is congruent.

What this requirement to differ essentially from the state of the art actually entails is difficult to specify. In the preparatory works to the Patents Act, NOU 1976:49, the following statement appears in the comments to section 2 on page 102: "The requirement for inventive step does not only entail that the invention must be new, but must also involve such a development of the art that this cannot be deemed to be obvious in relation to what is already known."

The standard of inventive step/non-obviousness reflects the requirements for granting a patent; a balancing of the fundamental considerations behind the patent institution, i.e. the desire to promote technical development by protecting the inventor's efforts and ensuring that the general technical development which continually takes place in a society is also protected.

The standard of inventive step/non-obviousness is subject to a professional assessment. By law, the inventor has the right to be granted a patent when the conditions for a patent are in place.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

The standard of inventive step assessment has changed during the last 20 years, if not in practice (biotech inventions are dealt with separately) at least with respect to the establishment of formal guidelines which are mandatory during examination of patent applications.

At the turn of the year 1999/2000 new Patent Guidelines were introduced to the examiners at the Norwegian Industrial Property Office. The new guidelines, the Patent Guidelines, included a Part C chapter IV "Assessment of the patentability criteria", which are to a large extent harmonised with those of EPO.

The problem solution approach was for the first time introduced to the examiners with the introduction of the new Patent Guidelines. At the turn of the century the approach was still not mandatory - it was only an option presented to the examiner as an optional tool to use in his assessment. The could - would approach (see e.g. item 9 below) has been a part of the problem solution approach from the introduction of the Patent Guidelines.

In October 2008 it became mandatory for the examiners to apply the problem solution approach, including the could - would approach, in relation to the inventive step assessment.

Seen from the applicants' view the Patent Guidelines have made it far easier to respond to office actions. It is easier to address issues pointed out by the examiner. Whether the introduction of the detailed patent Guidelines has led to a change in where the level of "differ essentially" is placed is difficult to say. The introduction of such detailed guidelines does not only make it easier and more predictable for the applicant, it also makes the file wraps far more interesting to study in case of litigation.

Before January 1, 1992 it was not possible to obtain a patent on a new pharmaceutical product explicitly by claiming the product, as claiming the product itself was prohibited by law. Instead, a method for production of this new pharmaceutical product was used to obtain patent protection (analogy method). This production method itself did not need to be inventive.

Pursuant to guidelines provided in the motifs of the Act amending the Patents Act of 1 February 2004, implementing Council Directive No 98/44/EU on the legal protection of biotechnological inventions, Norway is obliged to follow a strict practice in this field, see the Patent Guidelines part C, chapter IV, paragraph 2a.2. The implementation of this Directive has changed what is considered as patentable subject matter. It is now possible to seek protection for inventions directed against plants and animals as well as methods for producing the same as long as they are not purely biological. Plant varieties, animal varieties or essential biological methods are still exempted from patentability, however inventions which do not confine themselves to a specific plant or species of animal are considered patentable. Practicing of the directive is strictly enforced and it has also led to a number of regulations.

a. Restrictive practice

The Norwegian Industrial Property Office shall follow a restrictive practice under examination of applications directed to naturally existing biological matter. In the preparatory works it is explicitly indicated that the requirement for inventive step shall be strictly enforced, so as to make it difficult to obtain patent protection. Furthermore the scope of protection shall not be

extended beyond the wording of the claims. Norwegian practice shall follow the countries in Europe which enforces the most restrictive practice.
Reference is made to the Patents Act sections 1, 1a and 3c and in the Patent Guidelines Part C chapter IV 2a. 2.

b. Ethical problems

The Norwegian Industrial Property Office shall consult an Ethical board if practising an invention may involve ethical problems. The Patents Act establishes that the Norwegian Industrial Property Office shall consult the board if commercial exploitation would be contrary to ordre public or morality. A guidance list of non patentable subject matter is provided, this list includes among others (non-exhaustive):

a. Cloning of human beings.
b. Methods for changing the identity of human reproductive cells.
c. Use of human embryos
d. Inventions directed against genetic modifications of animals which may cause pain

The term for opposition is three years based on violation of the “ordre public” provisions, as opposed to the “normal” opposition period which is 9 months.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

The Norwegian Industrial Property Office publishes its Patent Guidelines for Examiners on its official website www.patentstyret.no. The Guidelines are essentially similar to the “Guidelines for Examination in The European Patent Office” and are updated in accordance with the Guidelines of EPO on a regular basis. Revisions are published and marked out in the Patent Guidelines for Examiners on the web site of The Norwegian Industrial Property Office.

Substantive examination reports issued by examiners normally follows a template, which is drawn up based on the Guidelines. Provided that subject matter is novel in view of cited prior art, a standardised inventive step assessment in line with the Guidelines will be issued by the examiners. The guidelines related to inventive steps are extensively used in response letters to outstanding substantive office actions; Patent Attorneys will normally address all relevant parts in the Guidelines in their responses to The Norwegian Industrial Property Office.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

The appeal division of the Norwegian Industrial Property Office is supposed to follow the same approach for inventive step assessment as the examining division; hence an in house harmonised practice applies with respect to the standard of inventive step.

Pursuant to Supreme Court case law, Rt 1975 p 603 Swingball and Rt 2008 p 1555 Biomar, the courts are supposed to be cautious when reviewing the decisions of the Norwegian Patent Office. As a starting point the decisions of the patent authorities are normative. Thus, the same standard for inventive step will apply. However, despite the repeated messages from the Supreme Court, the courts of appeal as well as the courts of first instance seem to invalidate a fair amount of patents in nullity proceedings. This is probably not due to any differences in the standard for inventive step, but is rather a consequence of other circumstances, such as new prior art being presented to the court, clarifications of the allegations during trial, as well as the fact that the court is set with expert lay judges in

addition to the professional judge. It may also be that the courts are more inclined to make overall assessments than the patent authorities.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

The literal meaning of the claims will be the starting point when deciding the scope of protection. Nevertheless, the claims will be read with a view to how the person skilled in the art would understand the claim. It has been discussed in case law, but is not yet solved, whether the relevant person is the person skilled in the art as per grant of patent or as per a later stage of claim construction during infringement proceedings.

In case a wording is defined in the patent specification or during the prosecution for the patent authorities, such meaning of the wording will most likely apply, even when such wording deviates from the regular semantic meaning or how the person skilled in the art would understand the claim.

6. Is it possible to read embodiments from the body of the specification into the claims?

The specification may serve as guidance to interpretation of the scope of the claims, the Norwegian Patents Act section 39. If the wording of the claims is ambiguous, an embodiment described in the specification is likely to be interpreted to be embraced by the claim, provided always that the wording or other communications during patent prosecution does not preclude such understanding. Thus, the inclusion of embodiments in the specifications does not expand the scope of protection unless also the wording of the claims may support the same.

There is no requirement that all possible embodiments of the invention are set out in the patent specification. However, the specification must describe how the invention may be worked within the whole claimed range.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

Following a recent decision from the Norwegian Industrial Property Office, boards of appeal (7 January 2010 no. 7886) an invention will be deemed to be disclosed if its teachings are *directly and unambiguously* learned from a prior art disclosure. Previously the Norwegian practice applied as a standard for novelty that the claimed invention showed *a reasonable technical difference* from prior art.

However, the teaching of the disclosure will still be interpreted with view to how the person skilled in the art would understand the relevant prior art. This embraces also such aspects as are not explicitly mentioned but would be understood to be present in view of the general knowledge that the skilled reader would inherently apply.

8. Do the answers to any of the questions above differ during examination versus during litigation?

We have no basis for stating that the situation will be different during examination versus during litigation.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

The requirement under section 2, subsection 1 of the Patents Act, that the invention must "differ essentially" from the state of the art is absolute, even if that prior art is represented by a single reference. Thus, provided that novelty is existent in view of a single prior art document an invention may still lack inventive step. The missing teachings may be provided by general knowledge in the art which is assumed to be known to the person skilled in the art.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

The combination of two or more prior art references is permitted, however as a rule of thumb, the combination of more than two documents is in itself often regarded as an indication of inventive step, see item 11 and 12 below. Again, according to the Patent Guidelines Part C, Chapter IV, 5.8 it is "permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art, but only where such a combination is near at hand to the person skilled in the art the day before the date of priority. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be a sign of the presence of an inventive step". The examiner is provided with examples of how to assess "which combinations are near at hand". Firstly the content of the documents must be so that it is natural to the person skilled in the art to combine them. If there are teachings in the closest prior art which points away from a combination, such a combination will normally not be considered to anticipate subject matter. Another indicator is whether the documents to be combined are from the same technical field or from remote areas. Furthermore, a combination between a revealed prior art document with textbooks or general technical knowledge in a technical field is permissible. A different situation occurs where the invention is a solution to a plurality of independent "partial problems". In the latter case several documents may be combined with the closest prior art for assessment of each individual partial problem. For the subject matter of the claim to be inventive, it suffices however that one of these combinations of features involves an inventive step, cf. The Patent Guidelines Part C, Chapter IV, 5.8.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

The closeness of the technical field to the claimed invention is relevant. A prior art document will only be considered in case it was natural for the person skilled in the art to consult the document.

The starting point will be the problem to be solved by the inventor of the claim under examination, In case the solution to the problem lies within the technical field of the prior art document, the test will be whether it was natural for the person skilled within that specific field to consult the document or disclosure. The Supreme Court held in the Biomar decision (Rt. 2008 p 1555) regarding the patentability of a claimed invention relating to cataract

among farmed fish, that it was relevant to look to a prior art document explaining the causes for cataract among kittens.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

There is no prohibition against combining more than two prior art references, and the Supreme court did so in the Biomar decision (Rt. 2008 p 1555) referred above. However, the need to combine more than two references is considered as an indication that the claimed solution is inventive. No other standard is applied when considering a plurality of references.

13. Do the answers to any of the questions above differ during examination versus during litigation?

We have no basis for stating that the situation will be different during examination versus during litigation

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The requirement of inventive step/non-obviousness is relative and varies depending on the character of the invention and the situation on the technical field in question. In general, the requirement of inventive step/non-obviousness is interpreted strictly in technical fields where there exist a need to restrict patent granting. Determining the technical problem on the basis of the closest prior art and the claimed solution is essential in order to apply the problem-solution approach, see answers to question no. 9.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

There is no requirement that the technical problem is disclosed or identified in the specification.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

There is no requirement for patentability that the applicant may prove any specific advantageous effects. Following case law, showing an advantageous effect may under the circumstances support the view that the claimed invention differs essentially from what was previously known. Advantageous effect is likely only to serve as a valid argument in the event that the question of inventive step is otherwise unclear.

17. Must the advantageous effects be disclosed in the as-filed specification?

The Norwegian Patents Act does not require explicitly or implicitly that an invention, to be patentable, must entail some technical progress or even any useful effect cf above. Nevertheless, advantageous effects, if any, with respect to the state of the art should be stated in the description (The Patent Guidelines Part C, Chapter II, 3.3.4, 3.2.3), and any such effects are often important in determining inventive step, cf. The Patent Guidelines Part C, Chapter IV, 5.3.1.

18. Is it possible to have later-submitted data considered by the Examiner?

The relevant arguments and evidence to be considered by the examiner for assessing inventive step may either be taken from the originally filed patent application or submitted by the applicant during the subsequent proceedings (see Patent Guidelines chapter VII, 3.2.2 and 3.2.3). The applicant shall however take care when arguing in favour of inventive step based on new technical effects, that such new technical effects can at least be implicitly understood from the originally filed application.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

Norwegian civil and procedural law is based on a free assessment of evidence. Thus, there are no formal requirements for the evidence to be presented. However, documentation or other proof of advantageous effect will be more convincing than a hypothetical example not supported by any empiric data. In case the applicant alleges an advantageous effect, it must be shown that the advantage stems from the invention itself, and not from other circumstances relating to the product or invention, such as marketing efforts.

20. Do the answers to any of the questions above differ during examination versus during litigation?

We have no basis for stating that the situation will be different during examination versus during litigation.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?

The general view is that teaching away is a relevant factor, and might even be an important factor, in the assessment of inventive step/ non-obviousness. It is assumed that it is not sufficient to take teaching away into account as a factor that a solution is regarded as less advantageous than alternative solutions. The question is if there are such problems that the skilled man had reason to ignore the solution in question.

There is no requirement that the teaching is explicit, e.g. in the literature. The general situation in the art may give basis to conclude that teaching away did exist.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

It is assumed that teaching away might be an important factor supporting inventive step. There is, however, limited case law on teaching away. On the basis of this there is reason to believe that teaching away is not a very important factor in the assessment of inventive step/non-obviousness in practice.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

Generally, arguments that support “teaching away” are often claimed by the applicant in response letters to office actions. However, the Patent Guidelines only mentions the wording

"teaching away briefly" in the Patent Guidelines Part C, section IV 8.4 it is stated that "As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle". In practice the applicant often uses teaching away as an argument against the combination of cited documents. In the Guidelines it is expressly indicated that a combination of documents shall be near at hand for the person skilled in the art. Hence the opposite, namely teaching away or pointing in a different direction, will render a combination of documents unlikely to the person skilled in the art.

There are no statistics showing the success rate of of the "teaching away" argument before the patent authorities, and in response to such argumentation examiners do not express why they cancel references, the examiners simply announces that argumentation has been considered and accepted or considered and rejected.

It is assumed that teaching away might be an important factor supporting inventive step. We have no basis for stating that the situation will be different during examination versus during litigation. It is, however, limited case law in relation to teaching away

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Secondary considerations as "long felt need", unexpected effect, commercial success or overcoming a technical prejudice among others are recognised under Norwegian practice. The latter, overcoming a technical prejudice, can also be viewed as an example of "teaching away", as subject matter in such cases often will be examples of technical solutions that points in an opposite direction as compared with cited references.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

The list of secondary considerations mentioned in the Patent Guidelines, and in the item above is not exhaustive.

In response letters to the Norwegian Industrial Property Office it will often be considered relevant to discuss the need to keep subject matter free for other traders in the art. That is, if subject matter for example merely claims a precisely specified mechanical device then the freedom to operate to the public will not be restricted, hence this points in the direction of a less strict exercise of judgement with respect to distinguishing features of subject matter. On the other hand, the more comprehensive the scope of protection is, the stricter the exercise of judgement with respect to inventive step will be. Arguments from the applicant in favour of a "narrow protection" and thus no need to keep subject matter free for other traders in the art is not subject to circumstantiation rather it is a question of exercise of judgement.

As to overcoming a prejudice it will normally be sufficient to refer to passages in prior art and that indicate that the sought invention overcomes a prejudice.

Arguments in favour of "long felt need" in the art may under some circumstances be supported by the mere mentioning of the fact. This can be the case if the sought subject matter pertains to a technical field which is well known to the public, such as house hold goods etc. On the other hand, if the invention satisfies a long felt need in a technical complex

or narrow area, it can be necessary to submit evidence in support of the meeting of a “long felt need”. The Norwegian Industrial Property Office is very reluctant to accept oral testimony, thus the submitted evidence shall preferably be documents where the content of the documents is possible to verify.

Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt need is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising), The Patent Guidelines Part C, chapter IV, 5.3.1. Hence, a close connection between the *claimed* invention and the secondary consideration namely commercial success is required.

As to unexpected effect as a secondary indicator in favour of inventive step it will often suffice to mention the unexpected effect in light of the technical effects rendered by prior art.

26. Do the answers to any of the questions above differ during examination versus during litigation?

In principle the judgement with respect to secondary indicators shall be the same before the examining division, the appeal division and before the court. However, it would seem that practice differs somewhat. One obvious reason is that facts submitted in testimony will be taken into account in court proceedings whereas this is seldom the case before the examining division or the appeal division. Complex cases where expert witness statement is important with respect to indication of secondary indicia are examples where at least the reasoning behind court decisions differs from those issued by the patent authorities. As the evidentiary facts usually differs between litigation and the proceedings before the examining division and the appeal division it is very difficult to exactly give any exact quotation of different assessment of secondary indicators between court decisions and those issued by the patent authorities. There are examples of court decisions which explicitly recite that inventive step is in place based on “long felt need” (Rt 1936 page 757 van Heusen decision), or overcoming prejudice (NIR 1998 page 113, Portland cement decision) or a combination where the freedom to operate to the public will not be restricted and where a long felt need in the art was existent (Rt 1964 page 1090 The Faber case).

As a conclusion there is reasons to believe that secondary considerations are considered more thoroughly in litigation than during examination before the examining division, at least based on the reasoning that testimonial statements usually cannot be taken into consideration by the examining division or the appeal division of the Norwegian Industrial Property Office.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction? If yes, please describe these issues, tests, or factors.

There are no other subjects than those discussed above that are relevant to the determination of the inventive step of a claimed invention.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other

authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

In the final step of the inventive step assessment the examiner is supposed to use a could - would approach, that is, to answer the question “whether there is any teaching in the prior art as a whole, that would have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves (The Patent Guidelines Part C, Chapter IV, 5.5.3). Moreover in the Patent Guidelines it is given examples as a tool for the examiner to carry out thecould - would approach. Note that this final step of the inventive step assessment follows steps which address the problem of indicating the closest prior art, and the establishment of an objective technical problem, see item 9 above.

The could - would approach is mandatory if novelty is existent and if the subject matter as such pertains to patentable matters, this is clearly shown in the introductory part of The Patent Guidelines Part C, Chapter IV, 5.5.3 where it is recited “In order to assess inventive step the so-called "problem-and-solution approach" should be applied. Examples from EPO Case law which applies this approach are plentiful and this is the reason why it is mandatory and not an option to use the could - would approach. Also, in Rule 27(1) (c) EPC it is stated that “the technical problem … and its solution can be understood” historically the enforcement of this rule by the Board of Appeal of EPO has led to this approach. In contrast to this, there is no national legislative basis for the same approach in the Patents Act or the Regulations to the Norwegian Patents Act, hence the mandatory use of the could - would approach is solely based on the fact that Norway is bound to follow European law and as such harmonise its patent guidelines, see our answer to question 23 above.

29. Does such test differ during examination versus during litigation?

There is no Supreme Court case law stating that the problem and solution approach has to be applied by the courts, whereas the guidelines of the Norwegian Patent Office positively requires that it be applied when assessing inventive step. Certain decisions from the Borgarting Courts of Appeals are based on the problem and solution approach, and others are not. In some decisions it is stated that the court has not used the problem and solution approach, but at the same time it has been underlined that the solution would have been the same irrespective of the approach taken.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

We are not aware of any such areas.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Although there seems to be a significant number of court decisions that deviate from the decisions taken by the patent authorities, we do not deem this to be due to any divergence in approach to inventive step, but mainly due to other circumstances. The factual bases of the cases are more likely to diverge due to developments in time and evidence rather than the legal standards applied to them.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

Norway has only recently become a party to the European Patent Convention, thus any divergence remains to be seen. As the Norwegian patent law is harmonized with the European Patent Convention, any substantive divergence is unlikely to emerge.

33. If yes, is this problematic?

N/A

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes, it is desirable.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

We believe so, at least with respect to the finding a common normative standard. However it may prove difficult to agree on regulations and guidelines, as preparation of the latter often are the object of the patent authorities or other embodiments which do not adhere to international law in the same manner as superior legislators. On the other hand, the Norwegian Patent Office has adopted the guidelines of the EPO, which shows that also an adaptation on the methods used when applying the standard may be harmonized.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art, EPC Article 56. The notion “inventive step” is commonly used in Germany, United Kingdom, Scandinavia, KIPO, JPO and SIPO, thus a definition which is based on the wording “inventive step” may be the best approach. Furthermore, “not obvious or non-obvious” is also commonly used as a measure for inventiveness in said jurisdictions. Under US law (35 U.S.C. § 103) the above is reversed as it is stated that “…subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art…”. As the largest countries/regions are familiar with interpretations of obvious/non obvious/not obvious it should be possible to agree on a definition based on the terms of EPC 56.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

We deem the problem solution approach to be a predictable analytical method for determining patentability.

SUMMARY
In order to qualify for patent protection, an invention must not only be novel, but must also "differ essentially" from the state of the art. To an average person skilled in the art, the invention must not be obvious from the prior art.

Norway has acceded to the EPC and can be designated for new European patents. The problem and solution approach is applied by the Norwegian Patent Office, and sometimes also by the courts, but not always.

Prior art and patent claims are construed from the viewpoint of the skilled person, relying also on "inherent disclosures" attributed to the skilled person by effect of common general knowledge.

Lack of inventive step over one single prior art reference is conceivable.
It is permitted to combine more than two references to show lack of inventive step, but there are few examples of this actually occurring. Identifying the technical problem is important, but the technical problem need not be disclosed in the patent specification.

Advantageous effects are not a requisite but should be disclosed in the specification. They may play an important role. Teaching away is a relevant factor in favour of inventive step, but really comes into play only if it is strong enough to give the skilled person good reason to disregard the solution.

Secondary considerations such as "long felt need", unexpected effect, commercial success and the overcoming of a technical prejudice are recognised in Norway.

The Norwegian group supports efforts to further harmonize inventive step / non-obviousness, but realises that it may be difficult to have the patent authorities and courts of many diverse jurisdictions apply the standard in a uniform way. The Norwegian group believes that article 56 EPC gives a useful definition and that the problem and solution approach is an analytical method that provides a relative high degree of predictability.

ZUSAMMENFASSUNG
Um für den Patentschutz zu qualifizieren, bedarf eine Erfindung nicht nur der Neuheit, sondern muss sich auch wesentlich vom Stand der Technik unterscheiden. Die Erfindung muss sich für einen Durchschnittsfachmann nicht offensichtlich aus dem Stand der Technik ergeben, d.h. naheliegend sein.

Norwegen trat dem EPÜ bei und kann für neue europäische Patente bezeichnet werden. Das norwegische Patentamt verwendet den „Aufgabe-Lösungs-Ansatz". Häufig, allerdings nicht ausschließlich, findet er auch in der Rechtsprechung Anwendung.

Der Stand der Technik und die Patentansprüche werden aus der Sicht des Fachmanns ausgelegt, wobei dem Fachmann, durch die Wirkung des allgemeinen Wissens, auch Kenntnis im Hinblick auf „implizite Offenlegungen" zugeschrieben wird.

Die Feststellung der mangelnden erfinderischen Tätigkeit über ein einziges Dokument aus dem Stand der Technik ist möglich. Die Kombination von mehr als zwei Dokumenten aus dem Stand der Technik ist auch denkbar, aber es gibt wenige Beispiele dazu, dass dies in der Praxis geschieht. Die Ermittlung des technischen Problems ist wichtig, aber das technische Problem muss nicht in der Patentschrift offengelegt werden.

Vorteilhafte Wirkungen sind nicht erforderlich, sollten aber in der Patentschrift offengelegt werden. Sie können eine wichtige Rolle spielen. Das „teaching away" ist ein relevanter und für die erfinderische Tätigkeit vorteilhafter Faktor, doch wirklich ins Spiel kommt er nur, wenn

er so stark von der Lehre der Erfindung wegführt, dass er dem Fachmann einen guten Grund dafür gibt, eine derartige Lösung zu missachten.

Sekundäre Faktoren, wie der seit langem gefühlte Bedarf, die unerwartete Wirkung, der kommerzielle Erfolg und die Überwindung eines technischen Vorurteils, werden in Norwegen anerkannt.

Die norwegische Gruppe unterstützt die Bemühungen um eine weitere Harmonisierung der erfinderischen Tätigkeit / Nichtoffensichtlichkeit, ist sich jedoch bewusst, dass sich die Erreichung einer einheitlichen Form der Anwendung dieses Maßstabes durch die Patentbehörden und die Rechtsprechung der vielen unterschiedlichen Rechtsordnungen als schwierig erweisen wird. Die norwegische Gruppe ist der Ansicht, dass Artikel 56 EPÜ hierfür eine brauchbare Definition schafft und dass der „Aufgabe-Lösungs-Ansatz“ einen verhältnismäßig hohen Grad an Vorhersagbarkeit bietet.

RÉSUMÉ

Afin de se qualifier pour la protection par brevet, une invention doit être nouvelle, mais elle doit aussi se distinguer essentiellement de l'art antérieur. Pour l'homme du métier l'invention ne doit pas être évidente vis-à-vis l'état de l'art.

La Norvège a adhéré à la CBE et peut être désignée pour les nouveaux brevets européens. L'approche problème-solution est appliquée par l'Office norvégien des brevets, et parfois aussi par les tribunaux.

Les revendications des brevets et l’art antérieur sont interprétés du point de vue de l'homme du métier, en lui attribuant aussi, par effet du savoir faire général, les divulgations inhérentes.

Il est concevable qu’une seule référence de l’état technique puisse suffire pour constater le manque d'activité inventive. Il est permis de combiner plus de deux références afin de montrer l'absence d'activité inventive, mais il existe peu d’exemples dans la pratique. Il est important d’Identifier le problème technique, bien qu’il ne doive pas obligatoirement être divulgué dans le brevet.

Les effets avantageux ne sont pas condition nécessaire mais devront être décrits dans la description déposée. Ils peuvent jouer un rôle important. Un préjuge est un facteur pertinent en faveur de l'activité inventive, mais ne joue un rôle vraiment important que s’il est suffisamment fort pour que l’homme du métier ne tienne compte de la solution.

Les considérations secondaires telles que le besoin ressenti depuis longtemps, les effets surprenants, le succès commercial et le dépassement d'un préjugé technique sont reconnus en Norvège.

Le groupe norvégien soutient les efforts visant à harmoniser davantage le concept de l'activité inventive, mais se rend compte qu'il peut être difficile d’obtenir que les offices de brevet et les tribunaux de plusieurs juridictions différentes appliquent la norme de façon uniforme. Le groupe norvégien estime que l'article 56 CBE donne une définition utile et que l'approche problème-solution est une méthode d'analyse qui fournit un degré relativement élevé de prévisibilité.